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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,143	08/18/2000	Mark Day	2762.2008-000	7239

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EXAMINER

EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 04/09/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/642,143

Applicant(s)

DAY ET AL.

Examiner

Bradley Edelman

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is a first office action on the merits of this case. Claims 1-55 are presented for examination.

#### ***Specification***

1. The disclosure is objected to because of the following informalities: the list of related cases on page 12 of the application must be updated to indicate present status, and should not include attorney docket numbers.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In considering claims 1, 11, 21, 31, 51, 52, and 53 these claims are ambiguous because the wording of the preamble is unclear. The preamble to these claims states to the effect of "a method/system/apparatus for identifying an address of a network element used by a particular client to obtain IP addresses." From this language, it is unclear whether the phrase "to obtain IP addresses" refers to the network element, or the client.

In further considering claims 4, 14, 24, 34, and 44, the limitation discussed in these claims is ambiguous (note: the claims all present the same limitation). The claims recite "handing back a test IP address for the client" and "recording an IP address of the client." These phrases are unclear because they do not indicate which device in the network performs the "handing back" and "recording" steps. The claims further recite "when the client subsequently sends a message directly to the test IP address." This limitation is also unclear because it is not clear as to which step "subsequently" refers. Multiple steps are claimed, and then the term "subsequently" is used. The claim does not state which step the "subsequent" step follows.

In further considering claims 6, 16, 26, 36, and 46, the claim states "forwarding a redirect message from a server to the client and the test message is to redirect the client to the test URL." This phrase is confusing, especially when read in combination with claims 1, 11, 21, 31, and 41 respectively. The claims do not clearly disclose which devices "forward" and "redirect" messages. Furthermore, the independent claims disclose that the client *sends* a test message to a test URL, but the dependent claim then modifies that by stating that the client is *redirected* to the test URL. Thus, when looking at the claims in their entirety, the steps of "sending," "redirecting," and "forwarding" are not clear. In addition, the claims, again in combination with the independent claims, mention "a test server" and then later mention "a server." It is

unclear if these two devices are the same server or different servers, and therefore, it is unclear which devices send which messages in the claimed invention.

Claims 51 and 52 contain similar ambiguous language, including “forwarding,” and “redirecting.”

In further considering claims 7, 17, 27, 37, and 47, these claims state “the redirected test message comprises the client IP address in the host name of the redirected test message.” This statement is unclear because claims 6, 16, 26, 36, and 46, from which these claims depend, mention two separate redirect messages – a redirect message sent to the client, and some sort of redirect message sent from the client to the test URL. Thus, it is not clear as to which of those messages the “redirected test message” refers.

In further considering claims 8, 18, 28, 38, and 48, these claims further fail to distinguish between the “redirected” messages. In addition, these claims state “causing the client to send a first message.” However, the term “first message” is unclear because the so many steps are already included in the claims that the word “first” can refer to any of those steps, and the claim does not specify as to which step the term “first” refers. If the “first message” is intended to occur before anything else in the claim, it should be stated as such. Otherwise, describing a “first message” after having described various other messages in previous claims, without further elaboration, is ambiguous.

In considering claim 53, the claim cites “a test URL comprising a unique host name to identify a test.” The step of “identifying a test” is not clear. The claim does not describe what type of test is being identified, or what the test is testing.

All other claims depend from these claims, and are thus rejected as well.

3. Claims 1, 11, 21, 31, 41, 51, and 52 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

Regarding claims 1, 11, 21, 31, and 41, the claims describe that a client sends a test URL to a test server, and then describe that the network element sends a request to resolve the host name in the URL to an IP address. However, the claims omit the essential step describing a means by which the network element obtains the test URL. The invention would not work without this step occurring, so the step must be included in the claim.

Regarding claims 51 and 52, the claims describe forwarding a test URL to a client, and then state that that forwarding causes a network element to make a request of the server. The claims do not disclose how the forwarding causes the network element to make a request. This step is essential to understanding how the rest of the process works, and cannot be omitted from the claims.

Claims 2-10, 12-20, 22-30, 32-40, and 42-50 depend from these claims, and are thus rejected as well.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 53-55 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Claim 53 essentially recites "a test URL." Claims 54 and 55 describe what the test URL are comprised of. However, without further claim steps, the test URL performs no function and is thus inoperative. A test URL by itself has no use. Claims 54-55 depend from claim 53, and are thus rejected as well.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all After Final papers: (703) 746-7238.

For all other correspondences: (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

BE  
April 2, 2003

  
GLENTON B. BURGESS  
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TECHNOLOGY CENTER 2100